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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,678	10/15/2003	Walter Aichholzer	510.1088	7076

23280 7590 08/11/2004

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EXAMINER

TUROCZY, DAVID P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/685,678	<b>Applicant(s)</b> AICHHOLZER ET AL.	
	<b>Examiner</b> David Turocy	<b>Art Unit</b> 1762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities: Paragraph 0001 claims priority to German Patent Application No. DE 102 48 270.5-43 filed on October 16, 2003, however, the German Patent Application No. DE 102 48 270.5-43 was actually filed on October 16 2002.

Appropriate correction is required.

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

3. The disclosure is objected to because of the following informalities: Paragraph 0027 discloses "thicknesses of up to 20  $\mu$ m for the second paint layer 7". There is confusion on which paint layer has a thickness of 20  $\mu$ m because paint layer 7 is

previously referred to as the first applied paint layer. The examiner considers the statement to read on the first paint layer rather than the disclosed second paint layer.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is unclear because the claim is incomplete. The claim reads "support material has a thickness of from 100 to 1200 and".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,2,4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al (U.S. Application No 10034106) in view of the teachings of Ellison et al (U.S. Patent No. 4810540).

8. With respect to claim 1, McCoy et al ('106) reference teaches of a multi-layered decorative film with a first and second layer thicknesses of 0.3-3 mils (.75 – 75 microns), see paragraph 31 and 32, and that the first layer is applied using a slot/dye coater. This type of coater would fall within the broad group of a knife coater because the downstream edge of the slot coater functions as a knife. McCoy et al ('106) fails to teach the relative thickness of the first layer being a factor of 3 to 5 times greater than that of the second layer.

Though the thicknesses are not disclosed as having the exact relationship claimed by applicant, the reference discloses a range that includes the relationship as claimed. The reference teaches of a range of .75 – 75 microns for either layer. The first layer can be 30 microns thick and the subsequent second layer can be 10 to 6 microns thick, or 3 to 5 times thinner than that of the first layer. In the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05. Therefore it would be *prima facie* obviousness to select any two thicknesses within the disclosed range of McCoy et al ('106), including the relative thicknesses claimed by applicant.

McCoy et al ('106) also fails to teach the application of a second layer by atomization.

Ellison et al ('540) discloses a method of making a multi-layered decorative film. It is noted that McCoy et al ('106) incorporates by reference Ellison et al (U.S. Patent No

Art Unit: 1762

4810540) in the body of the specification. Ellison et al ('540) discloses a process of applying the first coat by rolling and a second coat by spraying. It is noted that while McCoy et al ('106) discloses the use of a slot/dye coater, they also disclose that the application "could utilize other conventional coaters"(paragraph 19). It is the examiners position that it would have been obvious to one of ordinary skill in the art to have substituted the conventional spray coater of Ellison et al ('540) for the slot/dye coater of McCoy et al ('106). The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07. It is also noted that the applicants claim roll coating. Ellison et al ('540) discloses the use of rolling for the application of the first layer. It is the examiners position that it would have been obvious to one of ordinary skill in the art to have substituted the conventional roll coater of Ellison et al ('540) for the slot/dye coater of McCoy et al ('106).

9. With respect to claim 2, Ellison et al ('540) page 2, lines 8-19 teach that a transparent outer layer provides a glossy "wet look" to a multi-layer film. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a transparent outer layer for the purpose of providing a film with a "wet look".

10. With respect to claim 4, McCoy et al ('106) teaches "the coatings are applied wet-on-wet". See pg. 1, paragraph 6, line 3.

11. With respect to claim 6, claim 6 merely recites intended use. McCoy et al ('106) and Ellison et al ('540) both disclose multi-layered films of similar thickness and pliability to that claimed. Therefore the examiner maintains that the product disclosed by McCoy et al ('106) in view of the teaching of Ellison et al ('540) is capable of being applied to a bodywork component of a motor vehicle.

12. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al ('106) in view of Ellison et al ('540) as applied above, and further in view of Boris et al (U.S. Patent Number 6680104).

McCoy et al ('106) in view of Ellison et al ('540) are discussed above, but the references do not explicitly state that the transparent outer layer is formed by UV-curing varnish.

Boris et al ('104) discloses a multi-layer decorative film, similar to that disclosed by McCoy et al ('106). Boris et al ('104) teaches of an UV-curable protective lacquer system in the application of an outer protective layer. The examiner maintains that the outer layer of Boris et al ('104) provides the same function as that provided by the outer layer of Ellison et al ('540). Since both Ellison et al ('540) and Boris et al ('104) both disclose a transparent layer on flexible decorative films, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize UV-curable varnish to

Art Unit: 1762

form the outer transparent layer. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

13. Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al ('106) in view of Ellison et al ('540) as applied to claim 1 above, and further in view of Kiriazis et al (U.S. Patent No. 6132864).

14. With respect to claim 5, McCoy et al ('106) in view of Ellison et al ('540) fails to teach the drying the first layer before the application of the second layer.

Kiriazis et al ('864) discloses, in paragraph 28, the curing of the first layer can be carried out before overcoating with the second coat, or it is possible to overcoat the an uncured first coat with the second coat and then cure both layers together. Thus Kiriazis et al ('864) discloses that either wet-on-wet or wet-on-dry can be used for the application of plural coats on a film. Therefore, since McCoy et al ('106) teaches wet-on-wet application and Kiriazis et al ('864), making a similar film, discloses the use of either wet-on-wet or wet-on-dry, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute wet-on-dry method in place of a wet-on-wet method with the expectation of similar results.



15. With respect to claim 7, McCoy et al ('106) in view of Ellison et al ('540) fails to teach of a support thickness from 100 to 1200 microns.

Kiriazis et al ('864) discloses a multi-layered film, similar to that disclosed by Ellison et al ('540). Kiriazis et al ('864) teaches of a support material having a thickness of from 10 to 500 microns, page 1, column 1, lines 41-43. However, [a] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness. *In re Peterson*. See MPEP 2144.05. Since Ellison et al ('540), McCoy et al ('106) , and Kiriazis et al ('864) all teach of similar multi-layer films, of similar thicknesses and the capability of application to a component, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a support material having a thickness from 100 to 1200 microns.

16. With respect to claim 8, McCoy et al ('106) in view of Ellison et al ('540) fails to teach a component including a polymer material and a support thickness from 700 to 1200 microns.

In claim 8, " the component including a polymer material", merely recites intended use. McCoy and Ellison both disclose multi-layered films of similar thickness and pliability to that claimed by applicants. Therefore the examiner maintains that the product disclosed by McCoy et al ('106) in view of the teaching of Ellison et al ('540) is capable of being applied to a polymer material.

McCoy et al ('106) in view of Ellison et al ('540) also fails to teach a support thickness from 700 to 1200 microns.

Kiriazis et al ('864) discloses a multi-layered film, similar to that disclosed by Ellison et al ('540). Kiriazis et al ('864) teaches of a support material having a thickness of from 10 to 500 microns. See Kiriazis et al ('864) page 1, column 1, lines 41-43. A *prima facie* case of obviousness exists where the claimed ranges and prior art do not overlap but are close enough that one in ordinary skill in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 f.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. It is the examiners position that a film thickness of 700 microns provides the similar properties of that of 500 microns. Since Ellison et al ('540), McCoy et al ('106) , and Kiriazis et al ('864) all teach of similar multi-layer films, of similar thicknesses and the capability of application to a component, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize thicknesses, close to the referenced range, that have the same properties.

17. With respect to claim 9, McCoy et al ('106) in view of Ellison et al ('540) fails to teach a component including a metal.

In claim 8, " the component including a metal", merely recites intended use. McCoy et al ('106) and Ellison et al ('540) both disclose multi-layered films of similar thickness and pliability to that claimed by applicant. Therefore the examiner maintains

Art Unit: 1762

that the product disclosed by McCoy et al ('106) in view of the teaching of Ellison et al ('540) is capable of being applied to a metal.

McCoy et al ('106) in view of Ellison et al ('540) also fails to teach a support thickness from 50 to 300 microns.

Kiriazis et al ('864) discloses a multi-layered film, similar to that disclosed by Ellison et al ('540). Kiriazis et al ('864) teaches of a support material having a thickness of from 10 to 500 microns. See Kiriazis et al ('864) page 1, column 1, lines 41-43. In the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05. The examiner maintains that a thickness of 200 microns lies within the specific range of both Kiriazis et al ('864) and the claimed range. Since both Ellison et al ('540, McCoy et al ('106) , and Kiriazis et al ('864) all teach of similar multi-layer films, it would be obvious to one of ordinary skill in the art at the time the invention was made to utilize a support material within the claimed range.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spain et al (US. Patent 6579397) discloses a dry paint transfer process for making film for automotive body panels. Igarashi et al (U.S. Patent 6083564) discloses a method for forming multi-layer coating film. Reafler (U.S. Patent 5132148) discloses a flexible sheet material useful for protective and decorative

Art Unit: 1762


coatings. Krenceski et al (U.S. Patent 5268215) discloses the process of making a basecoat-clearcoat film.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-1874. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy

  
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